

REMARKS

Claims 1-24 are pending in this application, with claims 1, 7, 13 and 19 being the independent claims. Claims 1-2, 4-14, 16-20, and 22-24 have been amended. No new matter has been added.

In the Office Action dated April 27, 2007, claims 7-24 stand rejected under 35 U.S.C. §101 as allegedly being directed towards nonstatutory subject matter. Claims 1-6 and 13-18 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Claims 1, 7, 13 and 19 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,584,564 issued to Olkin, et al. Claims 2, 8, 14 and 20 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Olkin, et al. in view of U.S. Patent Publication No. 2002/0077985 issued to Kobata et al. Claims 3-4, 6, 9-10, 12, 15-16, 18, 21-22 and 24 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Olkin, et al. in view of Kobata et al. in further view of U.S. Patent No. 6,983,371 issued to Hurtado et al. Claims 5, 11, 17 and 23 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Olkin, et al. in view of Kobata et al. in further view of U.S. Patent No. 6,571,337 issued to Xiao.

Applicants gratefully acknowledge that the Office Action indicates that the submitted drawings are accepted by the Examiner.

Claim Rejections under 35 U.S.C. §101

In the Office Action, claims 7-24 are rejected under 35 U.S.C. §101 as allegedly being directed towards nonstatutory subject matter. The Office Action asserts that the claims provide no tangible computer components that work in conjunction with the functional descriptive material to impart functionality, and as a result the claims are not statutory because they purportedly fail the practical application requirement of §101 by failing to provide a useful, concrete, and tangible result. Applicants propose amending independent claim 7 to recite “A computer readable storage medium having stored thereon an email and an associated attachment”. Applicants propose amending dependent claims 8-12 as appropriate to reflect the amendment of claim 7 from which claims 8-12 depend, and further amending claim 8 to recite “The medium of claim 7” to correct a typo wherein the incorrect

independent claim (claim 1) was indicated. Applicants also propose amending independent claims 13 and 19 to recite “A computer-readable storage medium”. Reconsideration and withdrawal of the rejections under 35 U.S.C. §101 is respectfully requested.

Claim Rejections under 35 U.S.C. §112

Claims 1-6 and 13-18 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner asserts that the phrase “secondly applying RM protection to the email with the attached RM-protected attachment” in claims 1 and 13 is unclear as to whether the attachment is encrypted a second time or is left untouched when the email is encrypted. Applicants propose amending claims 1 and 13 to recite in relevant part “secondly applying rights management protection to the combined email and attached rights-management-protectable attachment”.

The Examiner further asserts that in claim 2 the phrases “the item” and “the signed rights data” lack antecedent basis. Applicants have amended claim 2 to address the alleged lack of antecedent basis. Applicants have also amended claim 14 to address similar language in that claim. In view of the present amendments, Applicants submit that claims 1-6 and 13-18 now fully comply with 35 U.S.C. §112, second paragraph. Accordingly, it is respectfully requested that the rejections, under 35 U.S.C. §112, second paragraph, of claims 1-6 and 13-18 be reconsidered and withdrawn.

In an effort to facilitate prosecution and further clarify the claimed subject matter, Applicants also propose amending all claims as amended herein to use complete terms instead of acronyms in order to synchronize term usage between the present application and related application 10/632,356.

Claim Rejections under 35 U.S.C. §102

In the Office Action, independent claims 1, 7, 13 and 19 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,584,564 issued to Olkin et al. (hereinafter referred to as “Olkin”). Applicants respectfully traverse this rejection.

Independent claim 1, as amended, is directed to:

A method of propagating rights management protection to an email and to an attachment of the email, the attachment comprising an rights-management-protectable document, the method comprising:

- authoring the email with the rights-management-protectable attachment;
- generating a content key;*
- generating a bind identifier;
- firstly applying rights management protection to the rights-management-protectable attachment of the email based on the generated content key and the generated bind identifier;
- attaching the rights-management-protectable attachment to the email;
- secondly applying rights management protection to the combined email and attached rights-management-protectable attachment based on the generated content key and the generated bind identifier;

wherein the rights-management-protected email and the rights-management-protectable attachment thereof share the generated content key and the generated bind identifier such that a license obtained for the rights-management-protected email and having therein the generated bind identifier and the generated content key can be applied to render the rights-management-protected email and also the rights-management-protectable attachment thereof.

In order for a reference to anticipate or render obvious claim 1, it must teach or suggest all of the recited elements, including those emphasized. Applicants respectfully submit that Olkin does not.

Olkin is directed to a secure email system. In Olkin, the separate component parts of an email are encrypted with a messageKey received from a security server. Each part of the message employs a unique seal, based on, among other things, a hash unique to that component. The Office Action alleges that Olkin in column 13, lines 53-60 teaches generating a bind ID, and column 14, lines 36-50 teaches the rights-management-protected email and the rights-management-protectable attachment thereof share the generated content key (KD) and the generated bind ID such that a license obtained from the rights-management-protected email and having therein the generated bind ID and the generated content key (KD) can be applied to render the rights-management-protected email and also the rights-management-protectable attachment thereof. Applicants respectfully disagree.

The Office Action equates Olkin's seals with the presently claimed bind ID. However, in Olkin, there is a unique seal for each part of the email, including any attachments. In Olkin, at column 13, lines 54-59, the security server generates "a list of computed seals (sList) **for each part of the secure e-mail** 14 being sent. The security server 24 computes the seals in sList as $H(H(H(x)+s+t+m+N.sub.m)+N.sub.m)$." Olkin further states "H(x) is from the set of hashes H(b), H(a.sub.1), H(a.sub.2) . . . H(a.sub.n) received from the software module 26" (column 23, lines 64-65). As recited in Olkin, the software module computes a unique hash for each component part of the email, including attachments. The software module sends the security server "**a list of computed hashes, one for the body, H(b), and one for each attachment, H(a.sub.1), H(a.sub.2) . . . H(a.sub.n)**" (column 13, lines 16-17). Since the hashes computed for each part of the email are different, the seals are by definition different from each other. This is clearly different from claim 1, which recites generating a bind identifier, wherein the rights-management-protected email and the rights-management-protected attachment thereof **share the generated content key and the generated bind identifier**.

Moreover, Olkin does not teach the generated bind identifier and the generated content key can be applied to render the rights-management-protected email and also the rights-management-protectable attachment. Olkin's seal is not used to render content of any kind, including the email and any associated attachments. The decryption process of Olkin is recited in column 15, line 44 - column 16, line 13. Olkin utilizes a password-based security process, requiring a password for decryption, and makes no use of the seal beyond the initial encryption. In contradistinction, claim 1 teaches that **the generated bind identifier and the generated content key can be applied to render the rights-management-protected email and also the rights-management-protectable attachment**.

Therefore, because Olkin fails to disclose or even suggest the recited elements, it cannot possibly anticipate claim 1. Similarly, Olkin does not disclose or suggest the elements recited in independent claims 7, 13, or 19. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections of claims 1, 7, 13 and 19 under 35 U.S.C. §102(e)

Claim Rejections under 35 U.S.C. §103

In the Office Action, claims 2, 8, 14 and 20 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Olkin in view of U.S. Patent Publication No. 2002/0077985 issued to Kobata et al. (hereinafter referred to as “Kobata”.) Applicants respectfully traverse this rejection.

As noted above with respect to claims 1, 7, 13 and 19, Olkin does not teach the “the rights-management-protected email and the rights-management-protectable attachment thereof share the generated content key and the generated bind identifier” feature of the claims. Applicants can find no such teaching in Kobata either. With regard to claims 2, 8, 14 and 20, Applicants note that such claims depend from claims 1, 7, 13 and 19, respectively, which Applicants respectfully assert have been shown above to be unanticipated and non-obvious. Therefore, such dependent claims 2, 8, 14 and 20 are also unanticipated and non-obvious, at least by their dependency from claims 1, 7, 13 and 19. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections of claims 2, 8, 14 and 20 under 35 U.S.C. §103(a).

The Office Action further rejects claims 3-4, 6, 9-10, 12, 15-16, 18, 21-22 and 24 under 35 U.S.C. §103(a) as allegedly being unpatentable over Olkin in view of Kobata in further view of U.S. Patent No. 6,983,371 issued to Hurtado et al. (hereinafter referred to as “Hurtado”). Applicants respectfully traverse this rejection.

Again, as noted above with respect to claims 1, 7, 13 and 19, Olkin does not teach the “the rights-management-protected email and the rights-management-protectable attachment thereof share the generated content key and the generated bind identifier” feature of the claims. Applicants can find no such teaching in Kobata or Hurtado, either in combination or standing alone. Applicants note that claims 3-4, 6, 9-10, 12, 15-16, 18, 21-22 and 24 depend variously, either directly and indirectly, from claims 1, 7, 13 and 19, which Applicants have shown to be unanticipated and non-obvious above. Therefore, such dependent claims 3-4, 6, 9-10, 12, 15-16, 18, 21-22 and 24 are also unanticipated and non-obvious, at least by virtue of their dependency from claims 1, 7, 13 and 19. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections of claims 3-4, 6, 9-10, 12, 15-16, 18, 21-22 and 24 under 35 U.S.C. §103(a).

In the Office Action, claims 5, 11, 17 and 23 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Olkin in view of Kobata in further view of U.S. Patent No. 6,571,337 issued to Xiao (hereinafter referred to as “Xiao”). Applicants respectfully traverse this rejection.

Once again, as noted above with respect to claims 1, 7, 13 and 19, Olkin does not teach the “the rights-management-protected email and the rights-management-protectable attachment thereof share the generated content key and the generated bind identifier” feature of the claims. Applicants can find no such teaching in Kobata or Xiao, either in combination or standing alone. Applicants point out that claims 5, 11, 17 and 23 depend variously, either directly and indirectly, from claims 1, 7, 13 and 19, which Applicants respectfully assert have been shown to be unanticipated and non-obvious above. Therefore, dependent claims 5, 11, 17 and 23 are also unanticipated and non-obvious, at least by virtue of their dependency from claims 1, 7, 13 and 19. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections of claims 5, 11, 17 and 23 under 35 U.S.C. §103(a).

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CONCLUSION

In view of the foregoing, Applicant respectfully submits that this application, including claims 1-24, is in condition for allowance. Favorable consideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

Date: August 22, 2007

/Aaron F. Bourgeois/
Aaron F. Bourgeois
Registration No. 57,936

Woodcock Washburn LLP
Cira Centre
2929 Arch Street, 12th Floor
Philadelphia PA 19104-2891
Telephone: (215) 568-3100
Facsimile: (215) 568-3439